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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/066,299	01/31/2002	Mindaugas F. Dautartas	23091/24 (ACT180)	2059
7590	10/14/2003		EXAMINER	
Maria M Eliseeva Brown Rudnick Berlack Israels LLP One Financial Center 18th Floor Boston, MA 02111			PERALTA, GINETTE	
		ART UNIT	PAPER NUMBER	
		2814		
DATE MAILED: 10/14/2003				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/066,299	DAUTARTAS ET AL.	
	Examiner	Art Unit	
	Ginette Peralta	2814	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on \_\_\_\_\_.

2a) This action is FINAL.                  2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 1-31 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-31 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
 \* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>11</u> .	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____. 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) 6) <input type="checkbox"/> Other: _____.
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## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sakaino et al. (U. S. Pat. 5,909,523) in view of Shaw et al. (U. S. Pat. 6,456,766 B1).

Sakaino et al. teaches in Fig. 15 a conventional optical submount that comprises a substrate; a trench in the substrate for holding an optoelectronic device on-edge; a groove in the substrate adjoining the trench; an optical fiber disposed in the groove; wherein the groove is perpendicular to the trench; wherein an optoelectronic device is disposed in the trench; wherein the optoelectronic device includes a contact pad, and the contact pad is soldered to the metallization layer; a lid disposed over the substrate; and the trench does not extend to an edge of the substrate.

Sakaino et al. discloses the claimed invention with the exception of an electrical connection pit adjoining the trench; and a metallization layer in the electrical connection pit.

Shaw et al. discloses in figs. 25 and 104, an optical submount that comprises a substrate; a trench in the substrate for holding an optoelectronic device on-edge; an

electrical connection pit adjoining the trench; and a metallization layer in the electrical connection pit; wherein the electrical connection pit with a beam is used for the disclosed intended purpose of compensating for the thermal expansion mismatch between substrates; wherein the electrical connection pit is at least partially filled with solder; wherein in fig. 25 it is further shown an optical waveguide disposed on the substrate, and terminating at the trench..

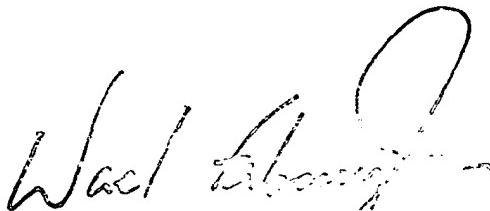
Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to form an electrical connection pit like the one taught by Shaw et al. in the invention of Sakaino et al. for the disclosed intended purpose of Shaw et al. of compensating for the thermal expansion mismatch between substrates in the optoelectronic submount. Furthermore, although in fig. 104 only one electrical connection pit is shown, it would have been obvious to one having ordinary skill in the art at the time the invention was made to form one or more electrical connection pits, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. St. Regis Paper Co. v. Bemis Co., 193 USPQ 8.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ginette Peralta whose telephone number is (703) 305-7722. The examiner can normally be reached on Monday to Friday 8:00 AM- 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wael Fahmy can be reached on (703) 308-4918. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

GP

  
WAEL AL-SABAGH  
SUPERVISORY PRIMARY EXAMINER  
TECHNOLOGY CENTER 2800